

REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-36 are currently pending of which claims 25-36 have been withdrawn from further consideration as being directed to a non-elected invention. Applicants respectfully request reconsideration of the rejected claims in light of the amendment and remarks presented herein, and earnestly seek timely allowance of all pending claims.

SCOPE OF CLAIMS NOT NARROWED

Claims 1-24 have been amended merely to address informal issues and to enhance clarity. It is intended that the scope of the claims remain substantially the same. Applicants respectfully submit that the amendments made to the claims do not add any new matter to the application and they are not narrowing, and are not made for a reason relating to patentability. Accordingly, it is submitted that these amendments do not give rise to estoppel and, in future analysis, claims 1-24 are entitled to their full range of equivalents.

35 U.S.C. § 102 REJECTION - Nagai

Claims 1-4 and 6-11 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Nagai et al. (USPN 6,104,388) ("Nagai"). Applicants respectfully traverse this rejection.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. See M.P.E.P. 2131; M.P.E.P. 706.02. Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Nagai fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, *inter alia*, "*wherein the sensor arrangement is designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position, that one of said elements is arranged to receive said force from the pen stem and thereby be urged to an activated position in electrical contact with the other element, and that, on relaxation of said force, the force-receiving element is arranged to automatically spring from the activated position back to the initial*

position " *Emphasis added.* Applicants respectfully submit that Nagai fails to disclose the above-identified claim features.

Nagai merely discloses a conventional pressure sensor 5 for an electronic pen, wherein the electronic pen includes a removable pen stem 1, a pen stem holder 2 consisting of a nozzle having a hemispherical projection 2a, a holding pipe 2b fixed thereto with a screw serving as a holding pipe fixer 2c or joined thereto with adhesive. *See col. 4, lines 21-24.* Nagai further discloses that in the force sensor 5, a fixed printed circuit board (PCB) 5d is connected to a resilient pressure-sensing plate 5c. The pressure sensor 5 further includes movable actuator 5b, which is adapted for connection to the pen stem 1. Thus, force applied to the pen stem is transmitted to the plate 5c, via the actuator 5b. *See col. 5, lines 30-35.* The plate 5c is made of a pressure-sensitive material, i.e., a material that changes its resistance with applied pressure. *See col. 5, lines 39-42.* The force applied to the pen stem 1 is sensed via the resulting change in electrical resistance in the material on the plate 5c, as indicated by a corresponding change in a voltage applied over the plate (see Figs 6-8: Vn, Vs, Vw, Ve).

Nagai is distinguished from the claimed invention in that, in Nagai, the sensor operation does not rely on any mutual movement between the plate 5c and the PCB 5d. Thus, it is respectfully submitted that Nagai cannot teach or suggest that the sensor arrangement is designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position as recited in independent claim 1. As mentioned above, claim 1 requires that one of either the electrode element or the closure element is arranged to receive a force from the pen stem and thereby be urged to an activated position in electrical contact with the other element, and that, on relaxation of said force, the force-receiving element is arranged to automatically spring from the activated position back to the initial position. In other words, the sensor arrangement of claim 1, including the closure element and the electrode element, has an initial position, in which the closure and electrode elements are electrically insulated from each other, and an activated position, in which the closure and electrode elements are in electrical contact with each other. Thus, the claimed invention is distinguished from Nagai in that it does not rely on the provision of a pressure-sensitive material as required by Nagai as demonstrated above. Instead, the closure and

electrode elements on the claimed invention form an electrical switch which is closed on application of a sufficient force on the pen stem and which is designed to automatically spring back from the activated position to the initial position when the force is removed.

Therefore, for at least these reasons, independent claim 1 is distinguishable from Nagai. Claims 2-4 and 6-11 depend from claim 1, directly or indirectly. Therefore, for at least the reasons stated with respect to claim 1 and further in view of novel features recited therein, claims 2-4 and 6-11 are also distinguishable from Nagai.

Accordingly, Applicants respectfully request that the rejection of claims 1-4 and 6-11, based on Nagai, be withdrawn.

35 U.S.C. § 103 REJECTION - Nagai

Claims 5 and 12-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Nagai. Applicants respectfully traverse. Claims 5 and 12-24 depend from claim 1, directly or indirectly. Therefore, for at least the reasons stated with respect to claim 1, and further in view of novel features recited therein, claims 5 and 12-24 are also distinguishable from Nagai.

In addition, Applicants respectfully submit that one requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference(s) to modify the reference(s) as proposed in the Office Action. *See M.P.E.P. 2143.01*. The claimed invention as a whole must be considered. It is not enough to determine whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See M.P.E.P. 2141.02*.

In this instance, the Examiner contends that the claimed invention of claims 5, 12, 13, 15, 21, and 24 is an obvious design modification. In essence the Examiner is arguing that the invention is merely design choice over Nagai.

The Examiner did not provide any suggestion or motivation within the cited reference of the above-mentioned modification. Applicants respectfully submit that Nagai fails to teach the claimed invention of claims 5, 12, 13, 15, 21, and 24. It appears that the only motivation to

modify has been gleaned from the teachings of the present application. This constitutes impermissible hindsight. *See M.P.E.P. 2141*. Simply put, there is no showing in the Office Action that the conclusion of obviousness was reached on the basis of facts gleaned from the prior art, and not from the claimed invention. *See M.P.E.P. 2143*.

Therefore, for at least these reasons, claims 5 and 12-24 are patentable over Nagi.

CONCLUSION


In view of the above remarks, it is believed that claims 1-24 are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam, Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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